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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,960	08/14/2004	George Joseph Nasscf JR.		4959

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VALETNOIR INC - A NEW YORK CORPORATION
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EXAMINER

VETTER, DANIEL

ART UNIT PAPER NUMBER

3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/710,960		NASSEF ET AL.	
	Examiner		Art Unit	
	Daniel P. Vetter		3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner:
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Claims 1-18 are pending in this application.

Claim Objections

1. Claim 1 is objected to because of the following informalities: the claim is missing an article, such as "an" from the beginning of the preamble. Appropriate correction is required.
2. Claim 16 is objected to because of the following informalities: "bases" appears to be a typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 1-6 and 16-18 are purported to be directed to a system, however the bodies of the claims recite a series of steps, as in a process claim. Therefore, it is unclear which statutory category of invention Applicant is attempting to claim, making the true scope of the claim unascertainable.

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6. Claims 7-15, while not reciting additional steps, contain the same above deficiency through dependency, and as such are rejected for the same reason.
7. Claim 5 recites the limitation "said other database systems" in line 2. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 5 is purported to be dependent upon claim 6. Dependent claims must depend upon a preceding claim. Appropriate correction is required.
9. Claim 6 recites the limitation "said gaming player" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.
10. Claim 7 is purported to be dependent upon claim 8. Dependent claims must depend upon a preceding claim. Appropriate correction is required.
11. Claim 8 recites the limitations "said selection criteria" in lines 2-3 and "the information" in line 3. There are insufficient antecedent bases for these limitations in the claim.
12. Claim 8 is purported to be dependent upon claim 9. Dependent claims must depend upon a preceding claim. Appropriate correction is required.
13. Claims 12-14, 17, and 18 contain the same deficiencies as claim 8 through dependency and, as such, are rejected for the same reasons.
14. Claim 10 is purported to be dependent upon claim 11. Dependent claims must depend upon a preceding claim. Appropriate correction is required.

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15. Claim 12 recites the limitation "said notification" in line 2. There is insufficient antecedent basis for this limitation in the claim.

16. Claim 13 recites the limitation "said notification" in line 2. There is insufficient antecedent basis for this limitation in the claim.

17. Claim 14 recites the limitation "said notification" in line 2. There is insufficient antecedent basis for this limitation in the claim.

18. Claim 14 recites the limitation "said other databases" in line 2. There is insufficient antecedent basis for this limitation in the claim.

19. Because of the above listed numbering errors it is impossible to determine the true scope of these claims. For the purposes of applying art, Examiner is interpreting each of these claims as only being dependent upon claim 1. In amending the claims, Applicant is requested to review the above misnumbered claims and claims that depend from them and ensure that proper antecedent basis exists for each limitation.

Claim Rejections - 35 USC § 101

20. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

21. Claims 1-4, 8-9, and 11-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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22. Claim 1 is purported to be directed to a system, however the body of the claim recites only data/software *per se*, which is not a statutory category of invention. Even if the invention were directed toward a system or process, a database not embodied on a physical medium is nothing more than an abstract idea, which is a judicial exception to patentability. For a judicial exception to become patentable subject matter, some physical transformation must occur, or a useful, concrete, and tangible result must be found. No physical transformation occurs. Merely "allowing" access is not enough of a real-world result to be tangible, as allowing can be reasonably interpreted to mean nothing more than not prohibiting. Accordingly, this claim is not directed to proper statutory subject matter.

23. Claims 2-4, 8-9, and 12-15 further limit certain abstract limitations of the invention, but none adds a tangible result nor removes it from reciting data/software *per se*. Accordingly, claims 2-4, 8-9, and 12-15 are directed to nonstatutory subject matter for the reasons stated above.

24. Claims 11 and 16-18 add a communication means and a searching step, which while ostensibly removing the claims from reciting merely data/software *per se* do not add a tangible result. Accordingly, claims 11 and 16-18 are directed to nonstatutory subject matter for the reasons stated above.

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25. As per claims 5-7, using the system to form a charter and contacting the player both remove the claims from being limited to data/software *per se* and add a tangible result, and thus are directed to proper statutory subject matter.

26. As per claim 10, a notification both removes the claim from being limited to data/software *per se* and adds a tangible result, and thus is directed to proper statutory subject matter.

Claim Rejections - 35 USC § 102

27. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

28. Claims 1-4, 6-9, and 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Friesen, et al., U.S. Pat. Pub. No. 2003/0050806 (Reference A of the attached PTO-892).

29. As per claim 1, Freisen, et al. teaches having a database (¶ 0093); having said database contain data about a traveler to and from a casino (¶ 0094); and allowing said data to be accessed by users of the system (¶ (0097).

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30. As per claim 2, Freisen, et al. teaches the system of claim 1 as described above. Freisen, et al. further teaches having said system being accessible by a user through the Internet (§ 0048).

31. As per claim 3, Freisen, et al. teaches the system of claim 1 as described above. Freisen, et al. further teaches having said data being historic data of said traveler (§ 0096).

32. As per claim 4, Freisen, et al. teaches the system of claim 1 as described above. Freisen, et al. further teaches having said historic data being the travel history, companions of said traveler. Freisen, et al. does not teach data in the form of seat assignments, however this difference is solely found in the non-functional descriptive material recited in the claim. Non-functional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. *In re Ngai*, 367 F.3d 1336, 1339; 70 USPQ2d 1862, 1864 (Fed. Cir. 2004); *cf. In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

33. As per claim 6, Freisen, et al. teaches the system of claim 1 as described above. Freisen, et al. further teaches having said system contacting said gaming player (§ 104).

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34. As per claim 7, Freisen, et al. teaches the system of claim 1 as described above.

Freisen, et al. further teaches said traveler is contacted based on a selection criteria (§ 104).

35. As per claim 8, Freisen, et al. teaches the system of claim 1 as described above.

Freisen, et al. further teaches said selection criteria is based on the information contained in said database (§ 104).

36. As per claim 9, Freisen, et al. teaches the system of claim 1 as described above.

Freisen, et al. further teaches said system compares said data against a rule set (§ 104).

37. As per claim 11, Freisen, et al. teaches the system of claim 1 as described

above. Freisen, et al. further teaches said system has a communication means (§

0081). The limitation "for players and users to contact each other" is merely a

statement of intended use and is only afforded patentable weight to the extent that it

imparts structural limitations on the invention, which are met by the cited prior art (§

0081).

38. As per claim 12, Freisen, et al. teaches the system of claim 8 as described

above. Freisen, et al. further teaches said notification is an E-mail (§ 0137).

39. As per claim 13, Freisen, et al. teaches the system of claim 8 as described

above. Freisen, et al. further teaches said notification mailing (§ 0056).

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40. As per claim 14, Freisen, et al. teaches the system of claim 8 as described above. Freisen, et al. further teaches said notification is telephonic (§ 0041).

41. As per claim 15, Freisen, et al. teaches the system of claim 6 as described above. Freisen, et al. further teaches said other databases are reservations systems databases (§ 0100).

42. As per claim 16, Freisen, et al. teaches the system of claim 1 as described above. Freisen, et al. further teaches having said users searching bases on qualifying criteria (§ 0142).

Claim Rejections - 35 USC § 103

43. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

44. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freisen, et al. in view of Watanabe, et al., U.S. Pat. Pub. No. 2003/0074236 (Reference B of the attached PTO-892).

45. As per claim 5, Freisen, et al. teaches the system of claim 1 as described above. Freisen, et al. does not explicitly teach having said other database systems being used

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to form a charter. Watanabe, et al. teaches having said other database systems being used to form a charter (Abstract). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate having said other database systems being used to form a charter into the system taught by Freisen, et al. in order to easily conclude a charter without the intervention of a broker (as taught by Watanabe, et al., ¶ 0013).

46. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freisen, et al. in view of Fitzgerald, et al., U.S. Pat. Pub. No. 2004/0039612 (Reference C of the attached PTO-892).

47. As per claim 10, Freisen, et al. teaches the system of claim 1 as described above. Freisen, et al. does not explicitly teach said system will notify if a rule set is broken. Fitzgerald, et al. teaches said system will notify if a rule set is broken (Abstract). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate said system will notify if a rule set is broken into the system taught by Freisen, et al. in order to avoid the customer dissatisfaction that may arise from the customer losing out on a desired advantage because of an unintentional violation of a promotion condition (as taught by Fitzgerald, et al., ¶ 0019).

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48. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freisen, et al. in view of Altman, et al., U.S. Pat. Pub. No. 2003/0120526 (Reference D of the attached PTO-892).

49. As per claim 17, Freisen, et al. teaches the system of claim 8 as described above. Freisen, et al. does not explicitly teach having said users searching for a plurality of travelers based on their travel information. Altman, et al. teaches having said users searching for a plurality of travelers based on their travel information (§ 0034). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate having said users searching for a plurality of travelers based on their travel information into the system taught by Freisen, et al. in order to take advantage of a unified trip record (as taught by Altman, et al., § 0034).

50. As per claim 18, Freisen, et al. teaches the system of claim 8 as described above. Freisen, et al. does not explicitly teach having said users searching for a plurality of travelers based on their travel history. Altman, et al. teaches having said users searching for a plurality of travelers based on their travel history (§ 0034). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate having said users searching for a plurality of travelers based on their travel history into the system taught by Freisen, et al. in order to take advantage of a unified trip record (as taught by Altman, et al., § 0034).

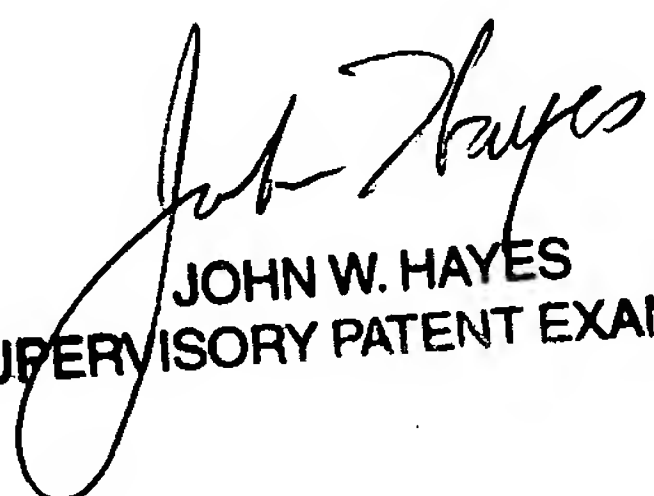
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Conclusion

51. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Vetter whose telephone number is (571) 270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER